

REMARKS

This amendment is responsive to a final Office Action mailed October 4, 2005. Applicant's response after final submitted January 4, 2006, resulted in the issuance of an Advisory Action on January 25, 2006. A request for continued examination is submitted herewith.

In the October 4, 2005, Office Action, the United States Patent and Trademark Office (hereinafter "the Office") rejected Claims 1, 2, 4-8, 15-19, 21-23, 26-28, 32, and 34, under 35 U.S.C. § 103(a) as being unpatentable in view of Hite et al. (U.S. 5,774,170), Bendinelli et al. (U.S. 6,061,719), and further in view of Zigmond et al. (U.S. 6,698,020). Claims 29-31 were rejected as being unpatentable in view of Hite et al., Bendinelli et al., Hinderks (U.S. 2001/0025377), and further in view of Zigmond et al. Claims 9-14, 20, 24, 25, and 33 were rejected as being unpatentable in view of Hite et al., Bendinelli et al., Zigmond et al., and Hinderks. Claim 3 was rejected as being unpatentable in view of Hite et al., Bendinelli et al., Zigmond et al., and further in view of Alexander et al. (U.S. 6,177,931).

Applicant requests reconsideration of the application in view of the foregoing amendments and the following remarks.

Claims 1-34 are pending in the present application. Claims 1, 15, 19, 22, 27, 29 and 32 are the independent claims. Claims 1, 7, 8, 10, 14, 15, 18, 19, 22, 23, 26, 27, 29 and 32-24 have been amended. In addition to demonstrating the patentability of the independent claims, applicant submits that the dependent claims are also patentable over the cited art. For brief descriptions of the Hite, Bendinelli, Hinderks, Alexander, and Zigmond patents, reference may be made to applicant's earlier response submitted January 4, 2006.

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Claims 1-14 Are Patentable Over the Prior Art

Applicant submits that the cited and applied references do not teach all of the elements recited in Claims 1-14. For example, with respect to Claim 1, applicant submits that none of the references, at a minimum, teaches "swapping the first advertisement with the second advertisement if a subscriber has specifically requested to receive substitute advertisement services."

In rejecting Claim 1, the Office combined the disclosures of Hite with Bendinelli and Zigmond. The Office acknowledged that Hite failed to disclose a subscriber choosing to receive substitute advertisement services. The Office did not cite Bendinelli for disclosing a facility by which a subscriber can elect to receive substitute advertisement services, but rather relied upon Zigmond. However, Zigmond also fails to disclose "swapping [a] first advertisement with [a] second advertisement if a subscriber has specifically requested to receive substitute advertisement services."

According to Zigmond, targeted advertising is delivered to all viewers according to ad selection criteria. See Col. 6, lines 6-12 of Zigmond et al. In some circumstances, viewers may modify the ad selection criteria by paying increased subscription fees and effectively prevent the delivery of advertising. Viewers in such circumstances either receive the targeted advertising or no advertising at all, and the option of receiving targeted advertising involves no action or request on the part of the viewers. But nowhere in Zigmond is there a suggestion of a method or system in which a first advertisement is swapped with a second advertisement if viewers specifically request substitute advertisement services. Rather, Zigmond teaches withholding advertising from those who pay the additional subscription fees. In contrast, the method in Claim 1 includes the feature of swapping advertisements if a subscriber has specifically

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requested to receive such a service. See, e.g., a description of this feature in the present application at page 15, lines 1-8.

Additionally, the Advisory Action in the present application acknowledged that "Zigmond does not provide the subscriber with a choice of receiving the original ads or the targeted swapped ads." In Claim 1, "a first advertisement [is] present in the television signal" which is "sen[t] ... to a client terminal via a first channel of a communication network." Absent the conditions for advertisement swapping (subscriber has specifically requested to receive substitute advertisement services and there is a match in the correlated information), the first advertisement that is present in the television signal is delivered to the subscriber. In view of the deficient disclosure of the prior art, particularly as acknowledged by the Office, applicant submits that Claim 1 is neither anticipated nor rendered obvious by the prior art and should be allowed.

Applicant further contends that the claims dependent on Claim 1 are patentable, both for their dependence on an allowable base claim and for the additional subject matter they recite.

For example, with respect to Claim 6, the feature of aggregating information related to the second advertisement includes "receiving trigger information from a third-party entity," which is not taught by the cited and applied art.

As another example, Claim 7 recites the method of Claim 1 in which link information associated with the first advertisement is replaced with link information associated with the second advertisement "by presenting the link information associated with the first advertisement to the subscriber and redirecting the subscriber according to the link information associated with the second advertisement." The Office cited Bendinelli, at Col. 3, lines 21-29, but the citation does not disclose this feature:

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For example, when the programming corresponds to an advertisement, the corresponding transmitted URL may identify a web site of the company or product being advertised. Similarly, news programming may be transmitted with URLs identifying one or more web sites which describe various news items in greater detail, and music video programming may be transmitted with URLs identifying web sites of the recording company, artist or studio associated with the music video.

As explained in the Advisory Action, the Office relied upon Hite for teaching the concept of advertisement swapping and upon Bendinelli for teaching the use of link information associated with advertisements. However, neither Hite nor Bendinelli teaches "presenting the link information associated with the first advertisement to the subscriber" and "redirecting the subscriber according to the link information associated with the second advertisement." Additionally, Zigmond does not overcome the deficiency of disclosure in the combination of Hite and Bendinelli. Accordingly, Claim 7 should be allowed.

As a further example of the allowability of the dependent claims, attention is drawn to Claim 8 which recites "opting in the client terminal to participate in the swapping of the first advertisement with the second advertisement by storing subscriber identification data for subscribers who specifically requested to receive substitute advertisement services." Applicant submits that the cited and applied art fails to teach this feature. Accordingly, Claim 8 should be allowed. For similar reasons, Claim 14 should also be allowed.

In view of the foregoing, reconsideration and allowance of Claims 1-14 is requested.

Claims 15-18 Are Patentable Over the Prior Art

Claim 15 is directed to an article of manufacture, comprising a machine-readable medium having instructions stored thereon. In one aspect, the instructions, when executed, cause a

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machine to "swap the first advertisement with the second advertisement if a subscriber has specifically requested to receive substitute advertisement services and if there is a match in the correlated information." The cited and applied art, alone or in combination, fails to disclose or suggest all of the elements of Claim 15. For at least the reasons discussed above with respect to Claim 1, Claim 15 is also allowable over the prior art.

Applicant further contends that the claims dependent on Claim 15 are patentable, both for their dependence on an allowable base claim and for the additional subject matter they recite. For example, Claim 18 is directed to an article of manufacture which includes instructions to replace link information associated with the first advertisement with link information associated with the second advertisement "by presenting the link information associated with the first advertisement to the subscriber and redirecting the subscriber according to the link information associated with the second advertisement." As with Claim 7 discussed above, the Office cited Bendinelli in combination with Hite and Zigmond to reject Claim 18, where in fact, Bendinelli teaches nothing about redirection, let alone presenting link information associated with a first advertisement and redirecting the subscriber according to the link information associated with the second advertisement. The simple association of a URL with a displayed program, as taught by Bendinelli, is unavailing. Hite and Zigmond, which were not cited for disclosing this element, are also deficient in this regard.

Reconsideration and allowance of Claims 15-18 is requested.

Claims 19-21 Are Patentable Over the Prior Art

Claim 19 is allowable for reciting elements that are not taught or suggested in the prior art, whether considered singly or in combination. Claim 19 recites, in part, an "aggregator further capable of sending at least some of the aggregated information to cause a swap of the substitute advertisement in place of an original advertisement that is provided to the broadcast

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center if a subscriber has opted-in by specific request to receive substitute advertisement services." Claim 19 further recites "wherein the swap with the substitute advertisement via use of the aggregated information includes redirection of a subscriber who clicks on a link that was present in the original advertisement using a link related to the substitute advertisement."

None of the cited and applied references teaches the foregoing features of the apparatus as claimed. Claim 19 is neither anticipated nor rendered obvious by the prior art and should be allowed.

Applicant further submits that the claims dependent on Claim 19 are patentable, both for their dependence on an allowable base claim and for the additional subject matter they recite. Reconsideration and allowance of Claims 19-21 is requested.

Claims 22-26 Are Patentable Over the Prior Art

Claim 22 is also allowable for reciting elements that are not taught or suggested in the prior art, whether considered singly or in combination. Claim 22 recites an interactive television system that includes "a broadcast center to send a television signal to a client terminal via a first channel of a communication network coupled to the broadcast center, wherein prior to being sent to the client terminal, the television signal includes information related to a first advertisement present in the television signal." The interactive television system further includes "an aggregator ... further capable of sending at least some of the aggregated information to cause a swap of the second advertisement in place of first advertisement if a subscriber has opted-in by specific request to receive substitute advertisement services."

Similar to Claim 19 above, none of the applied and cited references teaches swapping of a second advertisement in place of a first advertisement "if a subscriber has opted-in by specific request to receive substitute advertisement services," as claimed in Claim 22. For at least the reasons discussed above, applicant requests withdrawal of the rejection of Claim 22.

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Applicant further contends that Claims 23-26, which depend from Claim 22, are patentable for their dependence on an allowable base claim and for the additional subject matter recited therein. For example, Claim 23 recites the system of Claim 22, "wherein the information aggregated by the aggregator includes trigger information provided by a third-party entity." As another example, Claim 26 recites the system of Claim 22, "wherein the broadcast center is capable of sending a command to a client terminal to opt-in the client terminal when the subscriber is identified in a database of subscribers who have opted-in to receive substitute advertisement services," which is not evident in the cited and applied art.

Reconsideration and allowance of Claims 22-26 is requested.

Claims 27-28 Are Patentable Over the Prior Art

Claim 27 is directed to a method that includes "swapping the first advertisement with the second advertisement if a subscriber has affirmatively elected to receive substitute advertisement services and if there is a match in the correlated information, including presenting link information associated with the first advertisement to the subscriber and upon subscriber activation of the link information, redirecting the subscriber according to link information associated with the second advertisement." Neither Hite nor Bendinelli or Zigmond teach a subscriber that can affirmatively elect to receive substitute advertisement services, nor do they teach the feature of presenting first ad link information and upon subscriber activation of the link information, redirecting the subscriber according to second ad link information, as claimed. Accordingly, the subject matter recited in Claim 27 is patentable over the prior art. Claim 28, which depends from Claim 27, is also in patentable condition. Reconsideration and allowance of Claims 27-28 is requested.

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Claims 29-31 Are Patentable Over the Prior Art

Claim 29 is directed to an interactive television system comprising, in part, an "aggregator further capable of sending at least some of the aggregated information to cause a swap of the second advertisement in place of first advertisement if a subscriber has affirmatively elected to receive substitute advertisement services."

In the Office Action, the Office combined the disclosures of Hite, Bendinelli and Zigmond, which combination is defective as discussed above, with the disclosure of Hinderks. Hinderks also fails to disclose a facility by which a subscriber can affirmatively elect to receive substitute advertisement services, and does not cure the deficiencies of Hite, Bendinelli, and Zigmond. As with Claim 27 above, Claim 29 should be allowed.

Applicant further submits that the claims dependent on Claim 29 are patentable for their dependence on Claim 29, and for the additional subject matter recited therein. Reconsideration and allowance of Claims 29-31 is requested.

Claim 32-34 Are Patentable Over the Prior Art

Lastly, Claim 32 recites a method that includes, in part, "swapping the first advertisement with the second advertisement if a subscriber has individually opted-in to receive substitute advertisement services and if the correlated information determines that a swap is appropriate, including replacing link information associated with the first advertisement with link information associated with the second advertisement by redirecting the subscriber according to the link information associated with the second advertisement, wherein the second advertisement is swapped for the first advertisement during a time period substantially corresponding to the beginning and ending locations of the first advertisement."

At a minimum, the cited and applied references do not teach or suggest the foregoing elements recited in Claim 32. In particular, none of the references disclose a method in which a

subscriber can individually opt-in to receive substitute advertisement services, nor do they teach redirection of the subscriber according to link information associated with the second advertisement, as claimed. Accordingly, Claim 32 should be allowed.

Applicant further contends that Claims 33 and 34 are patentable, both for their dependence on Claim 32 and for the additional subject matter they recite. For example, Claim 33 is directed to the method of Claim 32, wherein replacing the link information associated includes "presenting the link information associated with the first advertisement to the subscriber and upon subscriber activation thereof, redirecting the subscriber according to the link information associated with the second advertisement," which is not taught or suggested in the prior art. The Office's reliance on Hinderks in combination with Hite, Bendinelli and Zigmond is unavailing in this regard.

Claim 34 is directed to the method of Claim 32, wherein replacing the link information includes "redirecting the subscriber to an address associated with the second advertisement." The Office cited Bendinelli as disclosing redirection to an address associated with the second advertisement, where in fact, Bendinelli teaches nothing about redirection. The simple association of a URL with a displayed program, as taught by Bendinelli, does not suggest or infer replacing link information by redirecting the subscriber to an address associated with the second advertisement.

Reconsideration and allowance of Claims 32-34 is requested.

CONCLUSION

In view of the foregoing amendments and remarks, applicant submits that a *prima facie* case of anticipation or obviousness cannot be shown. Accordingly, the claim rejections should be withdrawn. Independent Claims 1, 15, 19, 22, 27, 29, and 32 recite subject matter that is patentably distinguishable over the cited and applied references. In addition, Claims 2-14,

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16-18, 20-21, 23-26, 28, 30-31, and 33-34 are allowable based on their dependence from allowable independent claims and for the additional features they recite. Reconsideration and allowance of Claims 1-34 is respectfully requested.

As a final matter, applicant requests an indication that applicant's "3rd Supplemental Information Disclosure Statement" submitted on September 22, 2005, prior to the last Office Action, has been considered by the Examiner. An initialed copy of the IDS would be appreciated.

Should the Examiner identify any further issues needing resolution prior to allowance of the application, the Examiner is invited to contact the undersigned counsel at the telephone number indicated below.

Respectfully submitted,

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Date: 3.6.2006



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